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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,116	03/04/2008	Jacob Guth	034547-0118	2271
23428 7590 02/25/2010 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER GREENE, IVAN A	
			ART UNIT 1619	PAPER NUMBER
			MAIL DATE 02/25/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/596,116

**Applicant(s)**

GUTH ET AL.

**Examiner**

IVAN GREENE

**Art Unit**

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date 08/08/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the claims***

Claims 1-8 are currently pending and are presented for examination on the merits.

### ***Information Disclosure Statement***

The information disclosure statements submitted on 08/08/2006 was/were filed before the mailing date of the first office action on the merits. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the Examiner.

### ***Priority***

The U.S. effective filing date has been determined to be 04/05/2004, the filing date of the document PCT/EP05/03501. The foreign priority date has been determined to be EPO 04016057.4, the filing date of document 07/08/2004.

### ***Objections***

1. **Claims 5-8 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.**

### ***Claim Rejections - 35 U.S.C. 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1619

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 1. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by LORANT (US 6,465,402).**

**Disclosure of the Prior Art in view of the Claims**

LORANT discloses an oil-in-water emulsion cream as follows (col. 12):

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## Example 2

### Care Cream

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Aqueous phase:

Sepigel 305 (sold by the company Seppic)	2%
Preservatives	0.4%
Glycerol	3%
Demineralized water	q.s. for 100%

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Oily phase:

Volatile silicone oil (cyclohexasiloxane)	7%
Apricot oil	5%
KSG 21 (containing 28% of active material) (i.e. 1.4% of active material)	5%

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35 Procedure: The aqueous phase is prepared by dispersing, with stirring, the Sepigel 305 in the water containing the preservatives and the glycerol. The KSG 21 is then dispersed in the liquid oily phase and emulsification is subsequently carried out by dispersing, with vigorous stirring, the mixture obtained in the aqueous phase.

A slightly translucent cream is obtained which is very soft and fresh on the skin.

The above example comprises the vegetable oil, apricot oil, and 77.6% water. The apricot oil would have been expected to comprise vegetable oil bodies because the oil is derived from apricot oil seeds which inherently comprise vegetable oil bodies.

Furthermore, the limitation --washed vegetable oil bodies-- is considered a product-by-process limitation. And the patentability of a product does not depend on its

method of production. If the product in the product-by-process limitation is the same as from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See MPEP § 2113.

Regarding the limitation that processing temperature does not exceed about 40°C, the process described by LORANT includes only stirring the ingredients together and does not disclose any heating step. And because ambient room temperature would have been expected to be less than 40°C the limitation is met.

The instant specification does not expressly define lotion or cream. In view of the thesaurus (thesaurus.com) entry for lotion, claim 3 is being read as substantially synonymous and is rejected.

### ***Double Patenting***

2. Applicant is advised that should claim 3 be found allowable, claim 4 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following U.S. patent documents are cited for applicant's consideration: SENYEI (US 4,357,259); LEONG (US 5,269,166); MIDLER (US

4,073,743); RIBIER (US 5,753,241); WILLIAMS (US 6,638,981); SIMONNET (US 6,120,778); GOLINSKI (US 6,528,045); and TAMARKIN (US 2006/0233721).

Claims 1-8 are pending and have been presented for examination on the merits. Claims 5-8 have been objected to and not further treated on the merits; and Claims 1-4 are rejected under 35 U.S.C. 102(b). No claims allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IVAN GREENE whose telephone number is (571)270-5868. The examiner can normally be reached on Monday through Thursday 7AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bonnie Eyler can be reached on (571) 272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IVAN GREENE

/YVONNE L. EYLER/

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Examiner, Art Unit 1619

Supervisory Patent Examiner, Art  
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